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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,621	09/08/2000	Joyce Taylor-Papadimitriou	029395-17	3359

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EXAMINER	
DECLOUX, AMY M	
ART UNIT	PAPER NUMBER
1644	10

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/658,621	Applicant(s) TAYLOR-PAPADIMITRIOU ET AL.	
	Examiner Amy M. DeCloux	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- *Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.*
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33 and 35-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-33 and 35-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Claims 1-33 and 35-37 are pending.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Note: The groups are enumerated in Arabic numbers as opposed to Roman numerals due to the numerous inventions in the instant claims.

Note: Each claim will be examined only to the extent of the elected invention.

Group 1. Claims 1-3, 17, 18, 20-22 and 37, drawn to a polypeptide comprised by part of SEQ ID NO:1, and composition thereof, a vaccine, and a diagnostic composition, classified in class 530, subclasses 326-331, and class 514, subclasses 13-19 ,

Groups 2-34. Claims 2-3, drawn to a polypeptide comprise by part of SEQ ID NO:3 to SEQ ID NO:33 and SEQ ID NO:65-66
classified in class 530, subclasses 326-331, and class 514, subclasses 13-19 ,

Group 35, Claim 4, as encompassed by an analog of SEQ ID NO:1, classified in class 530, subclasses 326-331, and class 514, subclasses 13-19 ,

Groups 36-70, Claim 4, as encompassed by an analog of SEQ ID NO:3 to SEQ ID NO:33 and SEQ ID NO:65-66, respectively, classified in class 530, subclasses 326-331, and class 514, subclasses 13-19 ,

Group 71, Claims 5, 8-18 and 21-22, drawn to a polynucleotide encoding the polypeptide comprised by SEQ ID NO:1, classified in class 536, subclass 23.1, and class 435, subclasses 69.2, 252.3, 320.1 and 325,

Groups 72-104, Claims 5, 8-18 and 21-22, drawn to a polynucleotide encoding the polypeptide comprised by SEQ ID NO:3 to SEQ ID NO:33 and SEQ ID NO:65-66, respectively, classified in class 536, subclass 23.5, and class 435, subclasses 69.2, 252.3, 320.1 and 325,

Groups 105-139, Claim 7, drawn to a polynucleotide encoding an analog of SEQ ID NO:1, SEQ ID NO:3 to SEQ ID NO:33 and SEQ ID NO:65-66, respectively, classified in class 536, subclass 23.5,

Group 140, Claim 17, drawn to a composition wherein each component is specifically defined, classified in class 536, subclass 23.5, and in class 530, subclasses 326-331, and class 514, subclasses 13-19,

Group 141, Claim 19, drawn to a method for effecting a CTL response in a subject, classified in class 424, subclass 184.1,

Group 142, Claim 23, drawn to a T cell receptor, classified in class 530, subclass 350,

Group 143, Claims 24-25, drawn to a cell comprising a T cell receptor, classified in class 435, subclass 325,

Group 144, Claims 26-27, drawn to a product that selectively binds a T cell receptor, classified in class 530, subclasses 326-331,

Group 145, Claim 28, drawn to a method of identifying a product, classified in class 435, subclass 7.2,

Group 146, Claim 29, drawn to a cell that that comprises a product that selectively binds a T cell receptor, classified in class 435, subclass 325,

Group 147, Claims 30-32, drawn to a method of identifying a MHC Class I restricted response comprising contacting T cells with a polypeptide, classified in class 435, subclass 7.2,

Group 148, Claims 30-32, drawn to a method of identifying a MHC Class I restricted response comprising contacting T cells with an analog of polypeptide, classified in class 435, subclass 7.2,

Group 149, Claims 30-32, drawn to a method of identifying a MHC Class I restricted response comprising contacting T cells with a product that selectively binds a T cell receptor, classified in class 435, subclass 7.2,

Group 150, Claim 33, drawn to a method of diagnosing cancer comprising a polypeptide encompassed by SEQ ID NO:1, classified in class 435, subclass 7.2, or

Group 151, Claim 35-36, drawn to a method of causing the replication of MHC Class I restricted T cells comprising a polypeptide encompassed by SEQ ID NO:1, and

a pharmaceutical composition comprising said cells, classified in class 435, subclass 7.2.

3. The inventions listed as Groups 1-151 are distinct for the following reasons:

4. Groups 1-34, Groups 35-70, Groups 71-104, Groups 105-139, Group 142, Group 143, Group 144 and Group 146 are unique products, being drawn to a polypeptide, and analog of said polypeptide, a polynucleotide encoding said polypeptide, a polynucleotide encoding an analog of said polypeptide, a T cell receptor, a cell comprising a T cell receptor, a product that selectively binds a T cell receptor, and a cell that comprises a product that selectively binds a T cell receptor, respectively. Each of these products differs with respect to their structures and physicochemical properties, and are therefore patentably distinct. Each of the products within the first four sets of groups is distinct with regard to its specific biochemical properties and structure.

5. Group 141, Group 145, Groups 147/148/149, Group 150 and Group 151 are unique methods because each has a distinct endpoint and comprises distinct process steps. Group 147, Group 148 and Group 149 have identical endpoints but differ with respect to their process steps Therefore, Group 141, Group 145, Groups 147/148/149, Group 150 and Group 151 are patentably distinct each from the other.

6. Group I and Group 141/150/151 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the polypeptide, can be used as an immunogen in a process of making monoclonal antibodies, as well as in a process for effecting a CTL response in a subject or in a process of diagnosing cancer or in a process of causing the replication of MHC Class I restricted T cells.

7. Group 142 and Group 145 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the T cell receptor, can be used as an immunogen in a process of making monoclonal antibodies, as well as in a process of identifying a product that selectively binds a T cell receptor.

8. Group 1 and Group 147 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the polypeptide, can be used as an immunogen in a process of making monoclonal antibodies, as well as in a process of identifying an MHC Class I restricted response.

9. Group 35 and Group 148 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the analog of a peptide, can be used as an immunogen in a process of making monoclonal antibodies, .as well as in a process of identifying an MHC Class I restricted response.

10. Group 144 and Group 149 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, a product that selectively binds a T cell receptor, can be used as an immunogen in a process of making monoclonal antibodies, .as well as in a process of identifying an MHC Class I restricted response.

11. Inventions 140 and 1/35/71 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because, for example, the combination of a polynucleotide and a vector can be used for regulated expression of the encoded polypeptide. The subcombination has separate utility such as an immunogen in a process for making monoclonal antibodies.

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be

accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

14. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. a message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers **other than elections** related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located In Crystal Mall 1. The faxing of such papers must conform with the notice published In the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

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Group 1640, Technology Center 1600
March 8, 2002
Amy DeCloux
3-8-02